

Appl. No. 10/613,338  
Amendment to Office Action of 01.12.2005

**Remarks:**

Concerning the Information Disclosure Statement:

The Examiner states in the office action that he did not consider the reference material cited under "Other Documents" in the IDS filed with the application on 02 July 2003. The Applicant filed copies of the referenced web pages with the IDS as is referenced on the return postcard. Specifically, the return postcard lists 20 references as being enclosed with the initial filing. As indicated on the IDS, 19 of those references were the listed patents. The 20<sup>th</sup> reference was the "Several web pages concerning prior art wheel bags found in a Yahoo search". Absolutely no Patent Office notation is provided on the postcard indicating that less than 20 references were received by the Patent Office, so the Applicant logically assumes that the missing materials were inadvertently misplaced or lost by the Patent Office prior to the file reaching the Examiner.

The Applicant has enclosed several new web pages illustrating wheel bags of the general type that are known to have existed prior to the Applicant's present invention. Applicant respectfully requests that the Examiner not make any future rejection FINAL if the rejection is based in whole or in part on the references materials that were misplaced by the Patent Office as the Applicant should to be permitted to respond to any such rejections on the record and have any amendments related to such rejections entered.

In the Specification:

The first paragraph of page 2 has been replaced with a similar paragraph including the serial numbers and patent number (as applicable) of the related applications.

The second full paragraph on page 8 has been replaced with a similar paragraph eliminating the word "where" between "proximate" and "the center" from the original paragraph, thereby fixing an inadvertent typo.

In the Claims:

Claims 13 and 16-27 have been canceled without prejudice. New claims 28-40 have been added.

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**Independent Claim 1 (as amended) and Associated Dependant Claims:** The Examiner rejected Independent Claim 1 as anticipated under 35 USC 102 by each of Sampson, Montgomery and Bristol. Claim 1 has been amended to incorporate the subject matter of Claim 13, which the Examiner found to contain allowable subject matter. Accordingly, Claim 1 and its dependent claims 2-12 & 14-15 are in a condition of allowance.

**New Independent Claim 28 and Associated Dependent Claims:** Claim 28 recites a combination of a bicycle, a bicycle rack, a front wheel of the bicycle, and an enclosure, wherein the bicycle is secured to the bicycle rack, the enclosure is secured to the bicycle at two more locations and the front wheel is contained within the enclosure. None of the references cited in the Office Action teach, motivate or suggest this combination. Specifically, all the bicycle bags and/or enclosures taught in Montgomery, Sampson, Bristol, Jackson and Johnston are adapted to be used with the associated bicycle with a load contained in the respective bag and the front wheel attached to the bicycle to facilitate the riding of the bicycle. Further, because the bags in all of these references are configured for use while the associated bicycle is being ridden, they are not large enough to contain a front wheel associated with the bicycle as a bag large enough to contain the front wheel attached to the bicycle would render the bicycle unusable. For at least these reasons, Claim 28 and its dependent claims are in a condition for allowance over the prior art.

**New Independent Claim 34 and Associated Dependent Claims:** Claim 34 recites a bag for attachment to a bicycle that includes an enclosure which is sized to substantially contain a front wheel of the bicycle. The recited bag includes three connectors attached to one face of the enclosure with "each connector being adapted to securely attach with a portion of the bicycle".

Montgomery fails to anticipate Claim 34 as the pannier bag taught in this reference is not adapted for coupling to the bicycle itself. Rather, as indicated in the reference, the pannier bag is designed to attach at the top to the side rails of a rear carrier rack by way of two hooks 68. See column 1, lines 47-50 and column 3, lines 37-38. The bottom of the pannier is secured by way of a hook 32a at the end of a spring that is attached to a clip fastened to the bicycle near the rear axle. See column 3, lines 44-46. The rails of rear racks are normally relatively thin compared to the tubing of the bicycle frame itself and the various other components of the bicycle capable of carrying a load. According, the openings of the hooks are not large enough for the pannier to be

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received over a frame tube or other bicycle component and still be able to perform its intended function. Further, nothing in the reference suggests the various hooks 68 and 32a of the pannier bag could be attached directly to the bicycle sans the bicycle rack or the recited clip. In contrast, Claim 34 specifically requires that "each connector be adapted to securely attach with a portion of the bicycle". Neither a bicycle rear rack nor a later added clip is part of the bicycle but rather separate additions thereto.

Montgomery also fails to anticipate Claim 34 because the front bicycle wheel of the associated bicycle could not be contained within the enclosure. Both the height and width of the pannier bag are less than the diameter of a front wheel associated with a bicycle to which they are attached. This is necessitated by the design of the bicycle.

It would also not be obvious to modify the size of the pannier bag to allow it to contain a front wheel as a bag enlarged sufficiently would hinder or prevent a rider from using the bag in its intended fashion, which is to hold cargo to be transported using the bicycle. As stated in section 2143.01 of the MPEP, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose". Further, Montgomery provides no motivation for making the proposed modification as such a change would, as mentioned above, render the pannier bag unsuitable for its intended use.

For at least all of the for going reasons, Claim 34 and its dependent claims are not anticipated or rendered obvious by Montgomery.

The Samson and Bristol references also fail to anticipate Claim 34 as neither bag taught in these references can receive the front wheel of the bicycle to which the bag is attached therein. See Figs. 1 of both references.

Both bags are designed to be contained within the front triangle of a bicycle frame defined by the frame's top, bottom, head and seat tubes. If either bag extended outwardly beyond the down tube more than a small distance, it would contact the front wheel of the bicycle hindering the rider's ability to steer. If the bag extended significantly above the top tube, it would compromise the rider's riding position. If the bag extended outwardly beyond the seat tube, the bag would hit the rear wheel and hinder the rear wheel's free rotation. Also the bottom edge of the bag is dictated by the crankset as having the bag extend too far downwardly would hinder the rider's ability to pedal. Further, if the bag extends laterally outwardly more than a very small distance from the left and right sides of the top tube, the rider's knees would impact the bag during each pedal rotation and

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therefore hinder his/her ability to ride. Given these negative consequences, and the fact that the intended use of the respective bags is to provide storage for a rider while riding a bicycle, no motivation is provided to modify the bag taught in either reference so that it would be able to carry a front bicycle wheel of the associated bicycle.

Also, as discussed above concerning the Montgomery reference, any proposed modification to either the Bristol or Sampson bags cannot render either bag unsatisfactory for its intended purpose of providing a means for carrying objects while the associated bicycle is being ridden. See MPEP 2143.01. It is appreciated that if either bag were modified to fit a front wheel therein, the bag would necessarily interfere with the riding of the bicycle and renders the Bristol and Sampson bags completely unsuitable for use when the bicycle is being ridden.

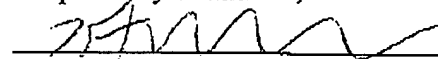
For at least all of the for going reasons, Claim 34 and its dependent claims are not anticipated or rendered obvious by Bristol or Sampson either alone or in combination with each other and/or the Montgomery reference.

#### Conclusion

The applicant believes the objections and the rejections of the Office Action have been overcome through amendment and remark. Accordingly, the application and all pending claims are in a condition of allowance. The Examiner is respectfully requested to contact the undersigned at 303.768.0644 if there are any other outstanding issues that would prevent the expeditious issuance of a Notice of Allowance in this case.

Dated this 24<sup>th</sup> day of February, 2005

Respectfully submitted,



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